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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Krister HANSSON et al.

Group Art Unit: 2125

Serial No.: 09/718,380

Examiner: S. Garland

Filed: November 24, 2000

For: PROCESS FOR ACHIEVING DECOR ON SURFACE ELEMENTS

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

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In response to the Office Action of September 1, 2004, Applicants respectfully request reconsideration.

Claims 1-21 and 27-32 are pending. Initially, as the objections to and rejections of the drawings, specification and claims under 35 USC § 112 and/or § 102(b), second paragraph, have not been repeated in the Office Action, Applicants thank the Examiner for withdrawing these rejections/objections.

Claims 1-21, 27-29 and 31 stand rejected under 35 USC § 103(a) as allegedly being unpatentable over McKee (U.S. Patent No. 5,568,931) in view of Chen et al. (U.S. Patent No. 6,617,009), optionally in further view of Newton et al. (U.S. Patent No. 6,504,559). These rejections have been carried forth from the Office Action of July 2, 2003.

However, as argued in the Amendment of May 28, 2004, Chen et al. is not a proper reference against the present claims. Applicants conceived of the subject matter recited in the claims of this application prior to the filing date of Chen et al., i.e., December 14, 1999, and were diligent until the filing of the priority document, i.e., SE 9904781-3 on December 23, 1999. Thus, Applicants respectfully present that Chen et al. is not a proper reference against the present claims of this application.

In support of applicants' argument of prior conception and diligence thereof, Applicants submitted a Declaration of Ingvar Sylegard under 37 CFR § 1.131 (hereinafter "the Sylegard Declaration") in order to antedate Chen et al. Although the Examiner cites various sections of the MPEP to support his argument that the Sylegard Declaration is insufficient to overcome the rejections, as not being made by a qualified party, the Office Action also cites MPEP § 715.07, for the premise that the declaration does not present facts to show priority of invention.

Firstly, however, as decided by the Federal Circuit in Bey et al. v. Kollonitch, et al., 806 F.2d 1024, 231 USPQ 967 (1986), the actions of a patent attorney can be used to support a priority claim. As the patent attorney is the only person who can swear as to his own activities on behalf of his client, Applicants have provided the Sylegard Declaration to show both corroboration of the conception of the invention prior to Chen et al and diligence until the filing of the Swedish priority application. Reconsideration is therefore requested.

In any event, Applicants additionally provide, as attachments hereto, the declarations of Krister Hansson and Diane Tate (Declaration of Krister Hansson under 37 CFR § 1.131 (hereinafter "the Hansson Declaration") - Attachment A, and Declaration of Diane Tate under 37 CFR § 1.131 (hereinafter "the Tate Declaration") - Attachment B, respectively).

Even if it is the Examiner's opinion that Ingvar Sylegard is not permitted to provide a suitable declaration, each of Mr. Hansson and Ms. Tate are certainly permitted, as Mr. Hansson is one of the inventors (37 CFR § 1.74(a) and Ms. Tate is an officer of the assignee of this application (37 CFR § 1.47(b)). Each of these declarations is being submitted to show conception of the invention before the filing of Chen et al. and diligence until the filing of the Swedish priority application.

In view of the foregoing, the Applicants have demonstrated that they have antedated the Chen et al. reference, and, without Chen et al., the rejection clearly fails to establish a prima facie case of obviousness.

In view of the above, it is respectfully submitted that all objections and rejections are overcome. Thus, a Notice of Allowance is respectfully requested.

Respectfully submitted,



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TPP/EPR/mat
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